



DOCKET NO. 2002US2

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :  
MASASHI GOTO, ET AL. : EXAMINER: GEYER, S.  
SERIAL NO: 10/821,843 :  
FILED: APRIL 12, 2004 : GROUP ART UNIT: 2812  
FOR: FILM-FORMING METHOD, :  
METHOD OF MANUFACTURING  
SEMICONDUCTOR DEVICE,  
SEMICONDUCTOR DEVICE, METHOD  
OF MANUFACTURING DISPLAY  
DEVICE, AND DISPLAY DEVICE

RESPONSE TO RESTRICTION REQUIREMENT

COMMISSIONER FOR PATENTS  
ALEXANDRIA, VIRGINIA 22313

SIR:

In response to the Restriction Requirement dated November 8, 2005, Applicants provisionally elect with traverse Group I, Claims 1-12, 14-17, and 19-22. Applicants make this election based on the understanding that Applicants are not prejudiced against filing one or more divisional applications that cover the non-elected claims.

Applicants traverse the outstanding Restriction Requirement as the outstanding Restriction Requirement has not established that an undue burden would be required if the Restriction Requirement was not issued and if all the claims were examined together. More particularly, MPEP § 803 states:

If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

In the present application no undue burden has been established if each of the claims were examined together. In contrast, the present restriction requirement subjects the Applicants to the added financial burden of prosecuting the claims in Group I separate from the claims in Group II.

Applicants further traverse this Restriction Requirement for the reason that the inventions of Groups I and II have not been shown to be distinct in the manner required by M.P.E.P. § 806.05(f).

As the noted portion of the manual indicates, the Patent Office must demonstrate either (1) that the process as claimed is not an obvious process of making the product and the process as claimed can be used to make other and different products, or (2) that the product as claimed can be made by another and materially different process.

Page 2 of the Restriction Requirement indicates that "[i]n the instant case, the process as claimed can be used to make a materially different product such as formation of a passivation layer of silicon oxide over circuitry on a substrate." However, the specific structural features of a product simply stated to be "materially different" are not set forth. Because the required showing as to a materially different product made by the process recited in the claims of Group I has not been set forth, Applicants cannot determine what the proposed product is, much less if it is simply different from the product of Group II or if it is "materially different" as is required. Thus, it cannot be said that the Office has met the requirement of MPEP § 806.05(f) as to showing a "materially different product" made by the recited process.

Accordingly, it is respectfully requested that the requirement to elect a single group be withdrawn, and that a full examination on the merits of Claims 1-22 be conducted.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.



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